**IN THE U.S. PATENT AND TRADEMARK OFFICE BEFORE
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of	Appeal No.
Hiroshi SATO et al.	Conf. 2326
Application No. 09/909,885	Group 3621
Filed July 23, 2001	Examiner C. Sherr

CONTENT DELIVERING METHOD, CONTENT
DELIVERING SYSTEM, AND CONTENT DELIVERING
PROGRAM

<u>**APPEAL BRIEF**</u>

MAY IT PLEASE YOUR HONORS: January 31, 2005

1.   **Real Party in Interest**

        The real party in interest in this appeal is the
current assignee, NEC Corporation of Tokyo, Japan.

2.   **Related Appeals and Interferences**

        None.

3.   **Status of Claims**

        Claims 29-44 were rejected and are the subject of the
present appeal.   Claims 1-28 have been canceled.

4.   **Status of Amendments**

        No amendments were filed following the Final rejection
of August 26, 2004.

5.   **Summary of Claimed Subject Matter**

Claims 29-34 are directed to a method for delivering rented content data (such as audio or video entertainment; Figure 4) to a customer through the internet (Figure 2). The invention includes defining, by the customer, a rental period during which access to the content data is to be permitted (page 15, lines 16-25; Figure 5), providing from a dealer to the customer a secret key that is useable only during the rental period (page 21, line 18 through page 22, line 6), providing from the dealer to the customer the content data in encrypted form through the internet (page 23, lines 4-13), and at the customer, decrypting and reproducing the content data using the secret key during the rental period (page 25, lines 8-16).

In other words, the customer defines the rental period and the dealer provides a key for decrypting the content data, where the key is useable only during the rental period that was defined by the customer.

Claims 35-38 are directed to a system for delivering rented content data to a customer through the internet that is substantially the same invention as the above-described method. The system includes a first server (130; page 14, line 16 through page 17, line 5) that receives the customer-defined rental period during which access to the content data is to be permitted and that provides to the customer a secret key that is useable only during the rental period defined by the customer, a content store

server (150; page 23, lines 3-22) communicating with the first server and that provides from the dealer to the customer the content data in encrypted form through the internet, and a customer terminal (110, 120; page 24, line 16 through page 25, line 16) communicating with the content store server and the first server and that decrypts and reproduces for the customer the content data provided from the dealer using the secret key during the rental period.

Claims 39-44 are directed to a program for delivering rented content data to a customer through the internet that carries out the above-described method. A further description of the program is not required as the steps being carried out are the same as the above-described method.

6. **Grounds of Rejection to be Reviewed on Appeal**

Claims 29-44 were rejected under 35 U.S.C. 103 as unpatentable over DOWNS et al. 6,226,618.

7. **Arguments**

DOWNS et al. is directed to a content delivery system that includes a key for decrypting content data provided from a dealer to the customer. DOWNS et al. do not disclose or suggest that the customer defines the rental period and that the key is useable only during the rental period defined by the customer.

DOWNS et al. disclose various usage conditions for the content data, but a rental period defined by the customer is not

among them. Note, for example, column 20, lines 42-49 (and column 21, lines 23-30) wherein the usage conditions are specified as number of plays and local copies and whether the content data is recorded to an external device. Further, there is nothing in DOWNS et al. that ties the customer-defined rental period to the period in which the key is useable. DOWNS et al. mention expiration dates at several places, but these refer to digital certificates (column 14, lines 19-27) and secure containers (column 25, line 28; column 30, lines 37-38; column 40, line 63), but not to an expiration date for the key, where that date is the same as the end of the rental period. DOWNS et al. also refer to rental periods (column 59, lines 43-45; column 61, lines 10-12), but do not associate a validity period of the key with a customer-defined rental period.

The Examiner acknowledges that DOWNS et al. do not specifically mention that the customer defines the rental period and that the key is useable only during the rental period defined by the customer, but the Examiner takes the position that the claims are nonetheless obvious. The Examiner explains that this rationale is based on "established business principle." The Examiner does not identify the unnamed established business principle and does not offer any evidence in support of this assertion.

The courts and the MPEP provide clear guidance for rejecting a claim in view of common knowledge or "well known"

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prior art (see, for example, MPEP §2144.03). As stated therein, "It is <u>never</u> appropriate to rely solely on 'common knowledge' in the art without evidentiary support on the record, as the principal evidence upon a rejection is based." (emphasis added) The Examiner must point to some concrete evidence in the record in support of this finding. In *In re Zurko*, 258 F3d 1379, 59 USPQ2d 1693, the Court of Appeals for the Federal Circuit held that an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence in support.

Further, the MPEP goes on to explain that when official notice is taken (it was not explicitly taken in the present application, but is at least implicit in the rejection) the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge. In any event, the lack of an explicit statement that official notice is being taken should not be an excuse to avoid providing specific factual findings predicated on sound technical and scientific reasoning to support the conclusion.

The Examiner's errors are that the "established business principle" relied upon is not identified, that there is no evidence of record that the business principle is known, and, on information and belief, that there is no established business

principle for providing data in encrypted form through the internet, where the customer decrypts and reproduces the content data using the secret key during a rental period, where the customer defines the rental period and the dealer provides a key for decrypting the content data, and where the key is useable only during the rental period that was defined by the customer.

The Examiner has not made a *prima facie* case that these claims are obvious over DOWNS et al. In view of this, it is believed that the rejections of record cannot be sustained and that the same must be reversed and such is respectfully requested.
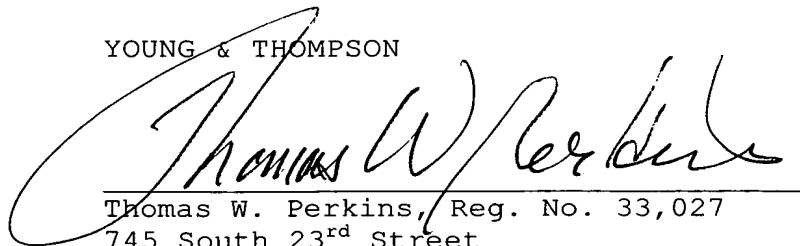
The claims involved in the appeal are set forth in the Claims Appendix.

There are no copies of evidence in the Evidence Appendix.

There are no copies of decisions in the Related Proceedings Appendix.

Respectfully submitted,

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8.   **Claims Appendix**

The claims on appeal:

29. A method of delivering rented content data to a customer through the internet, the method comprising the steps of:

defining, by the customer, a rental period during which access to the content data is to be permitted;

providing from a dealer to the customer a secret key that is useable only during the rental period defined by the customer;

providing from the dealer to the customer the content data in encrypted form through the internet; and

at the customer, decrypting and reproducing the content data provided from the dealer using the secret key during the rental period.

30.   The method of claim 29, further comprising the step of charging the customer for access to the content data based on the rental period defined by the customer.

31.   The method of claim 29, further comprising the step of providing from the dealer to the customer advertisement information in association with the provided content data.

32.   The method of claim 31, further comprising the step of selecting the advertisement information based on information about the customer.

33. The method of claim 29, wherein the defining step includes the step of the customer selecting a time for delivery of the secret key to the customer.

34. The method of claim 29, wherein the defining step includes the step of the customer selecting a time for delivery of the content data to the customer.

35. A system for delivering rented content data to a customer through the internet, comprising:

a first server that receives a rental period during which access to the content data is to be permitted, the rental period being defined by the customer, and that provides to the customer a secret key that is useable only during the rental period defined by the customer;

a content store server communicating with the first server and that provides from the dealer to the customer the content data in encrypted form through the internet; and

a customer terminal communicating with the content store server and the first server and that decrypts and reproduces for the customer the content data provided from the dealer using the secret key during the rental period.

36. The system of claim 35, wherein the first server charges the customer for access to the content data based on the rental period defined by the customer.

37.   The system of claim 35, wherein the first server also receives a time for delivery of the secret key to the customer that is defined by the customer.

38.   The system of claim 35, wherein the first server also receives a time for delivery of the content data to the customer that is defined by the customer.

39.   A program for carrying out a method of delivering rented content data to a customer through the internet, the program including instructions for carrying out the steps of:

defining, by the customer, a rental period during which access to the content data is to be permitted;

providing from a dealer to the customer a secret key that is useable only during the rental period defined by the customer;

providing from the dealer to the customer the content data in encrypted form through the internet; and

at the customer, decrypting and reproducing the content data provided from the dealer using the secret key during the rental period.

40.   The program of claim 39, further comprising the step of charging the customer for access to the content data based on the rental period defined by the customer.

41.   The program of claim 39, further comprising the step of providing from the dealer to the customer advertisement information in association with the provided content data.

42. The program of claim 41, further comprising the step of selecting the advertisement information based on information about the customer.

43. The program of claim 39, wherein the defining step includes the step of the customer selecting a time for delivery of the secret key to the customer.

44. The program of claim 39, wherein the defining step includes the step of the customer selecting a time for delivery of the content data to the customer.

9. Evidence Appendix

None.

10. Related Proceedings Appendix

None.